

**REMARKS**

In the Final Office Action<sup>1</sup>, the Examiner took the following actions:

rejected claims 7, 9, 10, 12, 15, 16, 36, 38, 39, 41, 44, and 45 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,867,821 to Ballantyne et al. ("*Ballantyne*") in view of U.S. Patent No. 5,740,231 to Cohn et al. ("*Cohn*");

rejected claims 1-3, 5, 8, 13, 30-32, 34, 37, 42, 47, and 49 under 35 U.S.C. § 103(a) as being unpatentable over *Ballantyne* in view of *Cohn* and further in view of U.S. Patent No. 5,805,666 to Ishizuka et al. ("*Ishizuka*");

rejected claims 11, 14, 17, 40, 43, 46, and 51-53 under 35 U.S.C. § 103(a) as being unpatentable over *Ballantyne* in view of *Cohn* and further in view of U.S. Patent No. 5,732,074 to Spaur et al. ("*Spaur*"); and

rejected claims 4, 6, 33, 35, 48, 50, and 54 under 35 U.S.C. § 103(a) as being unpatentable over *Ballantyne* in view of *Cohn* and *Ishizuka*, and further in view of *Spaur*.

Claims 1-17 and 30-54 remain pending in this application.

**Rejections of Claims 1-17 and 30-54 under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 7, 9, 10, 12, 15, 16, 36, 38, 39, 41, 44, and 45 under 35 U.S.C. § 103(a) as being unpatentable over *Ballantyne* in view of *Cohn* because a prima facie case of obviousness has not been established with respect to the claims.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such

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<sup>1</sup> As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Final Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, ability to combine references, assertions as to patentability of dependent claims) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” *M.P.E.P. § 2145*. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. *M.P.E.P. § 2143.01(III), internal citation omitted*. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original)*.

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” *M.P.E.P. § 2141(II)*. “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” *M.P.E.P. § 2141(III)*.

Independent claim 7 recites a method of accessing an information system using a portable access device including, among other steps, “establishing a communication link between said portable access device and said network server using a communication channel that is selected based on said communication profile and a

location of said portable access device with respect to said network server, wherein said communication channel is selected from the group consisting of: local wireless LAN, remote wireless LAN, wireline LAN, and Public Switched Telephone Network (PSTN)."

The Examiner relies on *Ballantyne* to allegedly disclose "establishing a communication link between said portable access device and said network server using a communication channel . . . wherein said communication channel is selected from the group consisting of: local wireless LAN, remote wireless LAN, wireline LAN, and Public Switched Telephone Network (PSTN)." (Final Office Action, page 4). This, however, is not correct.

*Ballantyne* discloses a master library (ML) 2 that is connected to a nursing care station and/or a bedside patient care station (PCS) 8, via a fiber optical or coaxial cable 4. (*Ballantyne*, Figure 1; and col. 11, lines 12-27). ML 2 utilizes a coaxial cable to transmit data to PCS 8, in *Ballantyne*, by selecting a channel based on the selected service. (*Ballantyne*, col. 9, lines 28-46). Moreover, PDA 10, in *Ballantyne*, "automatically transfers the modified health record or portions thereof to the PCS via the wireless/IR communications link." (*Ballantyne*, col. 12, lines 35-37).

Such a disclosure, however, does not teach or suggest the features of claim 7. This is at least because the "channels" of *Ballantyne* do not constitute the claimed "communication channel" that is "selected from the **group consisting of**: local wireless LAN, remote wireless LAN, wireline LAN, and Public Switched Telephone Network (PSTN)," as recited in claim 7 (emphasis added). The network channels in *Ballantyne* are disclosed to be different spectrums of frequency of a coaxial cable and are not selected from a group of "local wireless LAN, remote wireless LAN, wireline LAN, and

Public Switched Telephone Network (PSTN)," as recited in claim 7. (*Ballantyne*, col. 5, lines 23-25). Further, the wireless/IR communications link used to transfer the modified health record to the PCS in *Ballantyne* does not constitute the claimed "communication channel" that is "selected from the **group consisting of**: local wireless LAN, remote wireless LAN, wireline LAN, and Public Switched Telephone Network (PSTN). There is no disclosure of a selection from a group of channels in *Ballantyne* because, as noted above, a coaxial cable is specifically used to by PCS 8 to communicate with ML2, and wireless/IR communications link is specifically used to transfer modified health records from PDA 10 to PCS 8.

Moreover, *Ballantyne* does not teach or suggest "using a **communication channel** that is **selected based on said communication profile and a location** of said portable access device with respect to said network server," as recited in claim 7 (emphasis added). As noted above, the selection of channels in *Ballantyne* is limited to selection of a particular band of frequency based on a service request and is not "based on said communication profile and a location of said portable access device with respect to said network server," as recited in claim 7.

*Cohn* is directed to "a communication system 10 [that] maintains a universal database of all users of the communications system and their individual communications profiles including the various media in which the users can send and receive messages. For example, a single user may control and receive communications using an electronic mail facility, a voice mail facility, a facsimile facility and a video facility." (*Cohn*, col. 7, line 62-col. 8, line 7). In *Cohn*, network hubs 12, 14, and 16 use the universal database to translate a message in accordance with the

communication profiles and the translated message is then routed to a destination facility. (*Cohn*, col. 8, line 6-col., line 12).

*Cohn*, however, fails to remedy the above-noted deficiencies of *Ballantyne* with respect to claim 7. That is, even if the teachings of *Ballantyne* and *Cohn* are combined, the combination also fails to teach, suggest, or render obvious “using a communication channel that is selected based on said communication profile and a location of said portable access device with respect to said network server, wherein said communication channel is selected from the group consisting of: local wireless LAN, remote wireless LAN, wireline LAN, and Public Switched Telephone Network (PSTN),” as recited in claim 7. This is because the combination of *Ballantyne* and *Cohn* does not teach or suggest selecting a channel “**based on said communication profile and a location of said portable access device** with respect to said network server,” as recited in claim 7 (emphasis added). Moreover, the combination also does not teach or suggest selecting a communication channel from a group of “local wireless LAN, remote wireless LAN, wireline LAN, and Public Switched Telephone Network (PSTN),” as recited in claim 7. There is no disclosure of such a selection or such a group in *Ballantyne* or *Cohn*.

On pages of 21 and 22 of the Final Office Action, the Examiner acknowledges the differences between the cited references and the features of claim 7, and alleges:

The rejection in the previous Office Action **did not rely on** the definition of a “communication channel” as described by *Ballantyne* in the rejection and the mere fact that *Ballantyne* describes a “communication channel” that appears to be **different** from the “communication channel” as described by the applicant’s specification does not change the fact that

Ballantyne teaches the claim limitations as described in the 35 USC 103(a). (Emphasis added).

This, however, is not correct because “rejections on obviousness cannot be sustained by mere conclusory statements.” *M.P.E.P.* § 2141(III). Instead, [a] conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” *M.P.E.P.* § 2145. Further, “[o]ffice personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” *M.P.E.P.* § 2141(III). In this case, neither *Ballantyne* nor *Cohn* enable selecting a communication channel “**based on said communication profile and a location** of said portable access device with respect to said network server, wherein said communication channel is selected from the group **consisting of: local wireless LAN, remote wireless LAN, wireline LAN, and Public Switched Telephone Network (PSTN)**,” (emphasis added) as recited in claim 7. Moreover, while acknowledging the differences between the prior art and the claimed invention, the Final Office Action has not explained why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. Instead, the Final Office Action has provided a conclusory statement that *Ballantyne* and *Cohn* teach the claim limitations without providing some rational underpinning to support the legal conclusion of obviousness.

Accordingly, in view of the errors in analysis of *Ballantyne* and *Cohn*, the Final Office Action has neither properly determined the scope and content of the prior art nor ascertained the differences between *Ballantyne* and *Cohn* and the subject matter of claim 7. Further, the Final Office Action has not articulated a reason why one skilled in

the art would have found the features of claim 7 obvious. For at least the above reasons, the Final Office Action has not established a *prima facie* case of obviousness of claim 7. Thus, the rejection of claim 7 under 35 U.S.C. § 103(a) should be withdrawn.

Independent claims 12, 36, and 41, while of different scope, recite features similar to those of claim 7 and are thus also allowable over *Ballantyne* and *Cohn* for reasons similar to those presented above for claim 7. For example, claim 12 includes “establishing a communication link between said portable access device and said second network server using a communication channel that is . . . selected from the group consisting of: local wireless LAN, remote wireless LAN, wireline LAN, and Public Switched Telephone Network (PSTN);” claim 36 includes “establishing a communication link between said portable access device and said network server using one of a plurality of communication channels that is . . . selected from the group consisting of: local wireless LAN, remote wireless LAN, wireline LAN, and Public Switched Telephone Network (PSTN);” and claim 41 includes “establishing a communication link between said portable access device and said second network server using a communication channel that is selected based on said communication profile and a location of the portable access device with respect to said second network server,” features that are not taught or suggested by *Ballantyne* and *Cohn*.

Claims 9, 10, 15, 16, 38, 39, 44, and 45 are also allowable at least due to their dependence from one of the independent claims.

Accordingly, reconsideration and withdrawal of this rejection of claims 7, 9, 10, 12, 15, 16, 36, 38, 39, 41, 44, and 45 under 35 U.S.C. § 103(a) is therefore respectfully requested and deemed appropriate.

Applicant respectfully traverses the rejection of claims 1-3, 5, 8, 13, 30-32, 34, 37, 42, 47, and 49 under 35 U.S.C. § 103(a) as being unpatentable over *Ballantyne* in view of *Cohn* and further in view of *Ishizuka* because a prima facie case of obviousness has not been established.

Independent claims 1, 3, 30, and 32, while of different scope, recite features similar to those of claim 7. Thus, *Ballantyne* and *Cohn* do not teach, suggest, or render obvious these independent claims. In addition, *Ishizuka* fails to cure the above-noted deficiencies of *Ballantyne* and *Cohn*. For example, claim 1 includes “attempting, by the portable access device, to establish a communication link between the portable access device and the first network server using communication channel that is selected . . . from the group consisting of: a local wireless LAN, a remote wireless LAN, a wireline LAN, and a Public Switched Telephone Network (PSTN);” claim 3 includes “attempting, by the portable access device, to establish a communication link between the portable access device and the first network server using one of a plurality of communication media . . . selected from the group consisting of: a local wireless LAN, a remote wireless LAN, a wireline LAN, and a Public Switched Telephone Network (PSTN);” claim 30 includes “attempting, by the portable access device, to establish a communication link between the portable access device and the first network server using a communication channel . . . wherein the communication channel is selected from the group consisting of: a local wireless LAN, a remote wireless LAN, a wireline LAN, and a Public Switched



Telephone Network (PSTN); and claim 32 includes “attempting, by the portable access device, to establish a communication link between the portable access device and the first network server using one of a plurality of communication media . . . selected from the group consisting of: a local wireless LAN, a remote wireless LAN, a wireline LAN, and a Public Switched Telephone Network (PSTN),” features that are not taught or suggested by *Ballantyne, Cohn, and Ishizuka*.

Thus, independent claims 1, 3, 30, and 32 and dependent claims 2, 5, 8, 13, 31, 34, 37, 42, 47, and 49 are allowable over the cited references.

Accordingly, reconsideration and withdrawal of this rejection of claims 1-3, 5, 8, 13, 30-32, 34, 37, 42, 47, and 49 under 35 U.S.C. § 103(a) is therefore respectfully requested and deemed appropriate.

Applicant respectfully traverses the rejection of claims 4, 6, 11, 14, 17, 33, 35, 40, 43, 46, 48, and 50-54 under 35 U.S.C. § 103(a) as being unpatentable over combinations of *Ballantyne, Cohn, Spaur, and/or Ishizuka* because a prima facie case of obviousness has not been established.

Independent claim 51, while of different scope, recites features similar to those of claim 7. For example, claim 51 includes “attempting, by the access device, to establish a communication link between the access device and the first server, in accordance with the communication profile, wherein the attempting includes initiating a first attempt to establish communication with the first server via a local wireless network, initiating a second attempt to establish communication via a remote wireless network if the first attempt fails, and initiating a third attempt to establish communication via a public switched telephone network if the second attempt fails.” Thus, *Ballantyne* and *Cohn* do

not teach, suggest, or render obvious the features of this independent claim. In addition, *Ishizuka* and *Spaur* fails to cure the above-noted deficiencies of *Ballantyne* and *Cohn*. Thus, independent claims 1, 3, 7, 12, 30, 32, 36, 41, and 51 and dependent claims 4, 6, 11, 14, 17, 33, 35, 40, 43, 46, 48, 50, and 52-54 are allowable over the cited references.

Accordingly, reconsideration and withdrawal of this rejection of claims 4, 6, 11, 14, 17, 33, 35, 40, 43, 46, 48, and 50-54 under 35 U.S.C. § 103(a) is therefore respectfully requested and deemed appropriate.

Moreover, page 24 of the Final Office Action states “[t]he applicant pointed out that although the claims have substantially similar claim bodies the claims . . . the Examiner has removed the notification about potential duplicated claims.” While Applicant agrees with the Examiner’s conclusion Applicant does not agree with the statement that “claims have substantially similar claim bodies.” On page 33 of the Amendment filed February 4, 2009, Applicant asserted that claims 14 and 17, and 43 and 46 are not duplicate claims but are claims of different content and scope.

**CONCLUSION**

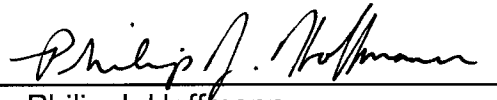
In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By:   
Philip J. Hoffmann  
Reg. No. 46,340

Finnegan, Henderson, Farabow,  
Garrett & Dunner, L.L.P.  
901 New York Avenue, N.W.  
Washington, D.C. 20001-4413  
(202) 408-4000